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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,206	03/01/2002	Brian Kohne	007287.00007	4670
22907 7590 01/12/2009 BANNER & WITCOFF, LTD. 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051			EXAMINER HOSSAIN, FARZANA E	
			ART UNIT 2424	PAPER NUMBER
			MAIL DATE 01/12/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/090,206

Applicant(s)

KOHNE, BRIAN

Examiner

FARZANA E. HOSSAIN

Art Unit

2424

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 August 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This office action is in response to communications filed 11/03/2008. Claims 1, 15 and 21-24 have been previously presented. Claims 2-7 and 16-20 are original. Claims 8-14 are amended.

Response to Arguments

2. Applicant's arguments filed 11/03/2008 have been fully considered but they are not persuasive.

3. Regarding the 101 rejection, the applicant amended claims 8-14 with the word tangible (Page 6).

In response to the argument, the word tangible still does not overcome the rejection. Based on the applicant's specification, the applicant can modify the amendment adding the word storage to computer readable medium (i.e. a storage computer readable medium) or removing the language in the specification defining medium to include non statutory matter such signals and carrier waves. The applicant could also cancel the claims.

4. Regarding Claim 1, the applicant argues that there is no reason to modify Reynolds to include disclosures in Rowe (Page 6). The applicant argued that the purpose of Reynolds is to overcome the limitations with passive television program guides (Page 6). The applicant argues that the Office mischaracterized the nature of those remarks and did not fully respond to the applicant's remarks (Page 7). The applicant argues that Reynolds paragraphs describes the frustration a user experiences being forced to wait until a list of program listings scrolls (Page 7). The applicant argues there is an oversimplification under *KSR* but then states that the Court in *Ortho-McNeil Pharmaceutical, Inc. v. Mylan Labs Inc.*, 520 F.3d 1358, 1364 (Fed. Cir. 2008) concludes flexible application of the teaching suggestion motivation (TSM) test assures the obviousness test proceeds on the basis of evidence that arises from the time of the invention (Pages 7-8). The applicant argues that since the combination of the references is improper the claim is allowable (Page 8). The applicant argues that the prior art fails to disclose displaying selected content is overlapped by information related to the first broadcasted program (Page 8). The applicant then states that the Office did not state how Rowe disclosed these features and therefore is led to believe that Reynolds allegedly disclose the features (Page 8).

In response to the argument, the examiner respectfully disagrees. The examiner has considered the arguments and will respond to each argument made by the applicant. Reynolds in paragraphs 0003-0004 provides background information and explains that people are frustrated waiting to view passive guides. There is nothing in Reynolds that states it cannot be combined with other program guides. The applicant

is focusing on two paragraphs and not the actual invention of Reynolds. Furthermore, the motivation to combine the two references is provided in Rowe. Reynolds discloses a "hybrid" guide which is an interactive guide with passive elements (Pages 8-9, paragraphs 0088-0093). The examiner would also like to re-assert that an interactive programming guide is met by an electronic programming guide that is interactive including allowing a user to select programs, which allows interaction between a guide and a user. The applicant is correct Rowe is not use to disclose elements of displaying selected content in the background area of the interactive programming guide, wherein the selected content is overlapped by information related to the first broadcast program (See maintained rejection). Reynolds discloses an interactive guide (Pages 8-9, paragraph 0090-0091) and based on an indication by a user for a program, overlaying interactive features on the background area including graphic display area or any suitable display area of the interactive guide (Pages 8-9, paragraph 0090-0093, 0096 Figures 3a, 82, 84, 3b, 87, 91, Figure 6, 91) – See rejection. The examiner would also like to re-assert Reynolds discloses after a selection but does not explicitly disclose determining that the first broadcasted program is selected for at least a time greater than a predetermined threshold; and a fourth unit, responsive to determining the that the first broadcasted program is selected for at least a time greater than the predetermined threshold, displaying the selected content in the electronic program guide. Rowe discloses determining that the first broadcasted program is selected for at least a time greater than a predetermined threshold (Column 10, lines 35-40, Figure 1, 32, 34); and a fourth unit, responsive to determining the that the first broadcasted program is

selected for at least a time greater than the predetermined threshold, displaying the selected content in the electronic program guide (Column 10, lines 18-40, Figure 1, 38, 34). The examiner would like to point out that Rowe discloses these features by stating that there is a short default time-out period and if its has expired than the display will change so that the rapid and unnecessary updating of displays is prevented if the subscriber is navigating through the EPG (Column 10, liens 35-45). The Rowe reference can be combined with the Reynolds reference as Rowe discloses an interactive program guide (Figures 2-4,6, 7 and 8) for the purpose of displaying content in response programming information in response to a selection of a category of programming information (Column 1, lines 11-15).

Furthermore, in *KSR International Co. Teleflex Inc.*, 127 S.Ct 1727, No. 04-1350, slip. op. at 12 (2007), the Court found that if all the claimed elements are known in the prior art of Reynolds and Rowe as discussed above then one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yield predictable results to one of ordinary skill in the art at the time of the invention. The examiner disagrees on the oversimplification of the *KSR* rationale. The elements of the claims as provided by the references are found above. In *Ortho*, the Court concluded that a flexible application of the TSM test assures the obviousness or motivations. The application of the claims is found in the broadest reasonable interpretation and a motivation was provided. There is no reason as to why to program guides particularly two interactive program guides

cannot be combined as found in the prior art. The examiner has addressed this argument several times and finds it unpersuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, in order to prevent rapid and unnecessary updates of the program display if the user is simply scrolling through the program guide (Column 10, lines 38-40) as disclosed by Rowe.

The examiner has answered applicant's request to address the substance of Applicant's remarks. However, the examiner would also like to point out that the applicant's claim language can be interpreted in different ways. The applicant may not agree with the rejection and can continue to disagree with the current rejection however the claim language as written is met by the combination of Reynolds and Rowe. The rejection of the claims is maintained and the remarks of the applicant did not overcome the rejection.

The applicant argues that similar arguments would be made for the remaining independent claims and all dependent claims. See above argument for response to arguments.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 8-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 8 is drawn to functional descriptive material recorded on a computer readable medium. Normally, the claim would be statutory. However, the specification, at Page 18, paragraph 0032-0033 defines the claimed computer readable medium as encompassing statutory media such as a "EEPROM", "disk drive", "optical disk", etc, as well as ***non-statutory*** subject matter such as a "signal" and "carrier wave."

A "signal" embodying functional descriptive material is neither a process nor a product (i.e., a tangible "thing") and therefore does not fall within one of the four statutory classes of § 101. Rather, "signal" is a form of energy, in the absence of any physical structure or tangible material.

Because the full scope of the claim as properly read in light of the disclosure encompasses non-statutory subject matter, the claim as a whole is non-statutory. The examiner suggests amending the claim to include the disclosed tangible computer readable media, while at the same time excluding the intangible media such as signals, carrier waves, etc. Any amendment to the claim should be commensurate with its corresponding disclosure.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds et al (US 2006/0010469 and hereafter referred to as "Reynolds") in view of Rowe et al (US 5,812,123 and hereafter referred to as "Rowe").

Regarding Claims 1, 8 and 15, Reynolds discloses a method, a computer readable medium, a method, a computer readable medium storing instructions that when executed by a processor, cause the process to perform the method (Page 8, paragraphs 0080, 0082, 0084, 0086, and system (Figure 4, Figure 5, Figure 1) comprising:

a first unit to receive input identifying a first broadcasted program (Figure 4, 22, 28, Figures 2a-d, 22, Figure 3a, Figure 3b);

a second unit to select content (Page 7, paragraph 0076, Figure 4, 40), based on the input, to be displayed in a background area of an interactive programming guide (Figures 3a, 3b, Figures 6, 7, 8a, Pages 8-9, paragraphs 0087, 0089-0091).

A fourth unit configured to display the selected content in the background area of the interactive programming guide, wherein the selected content is overlapped by

information to the first broadcasted program (Pages 8-9, paragraphs 0087, 0089-0092, Figure 5, 42). Reynolds is silent on a third unit determining that the first broadcasted program is selected for at least a time greater than a predetermined threshold; and a fourth unit, responsive to determining the that the first broadcasted program is selected for at least a time greater than the predetermined threshold, displaying the selected content in the electronic program guide. In analogous art, Rowe discloses a method, a computer readable medium, a method, a computer readable medium that perform operations, and system comprising: a first unit to receive input identifying a first broadcasted program (Figure 1, 32); and a second unit to select content (Figure 1, 40), based on the input, to be displayed in a background area of an interactive programming guide (Figures 2-4, 6, 92). Rowe discloses a third unit determining that the first broadcasted program is selected for at least a time greater than a predetermined threshold (Column 10, lines 35-40, Figure 1, 32, 34); and a fourth unit, responsive to determining the that the first broadcasted program is selected for at least a time greater than the predetermined threshold, displaying the selected content in the electronic program guide (Column 10, lines 18-40, Figure 1, 38, 34). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Reynolds to include a third unit determining that the first broadcasted program is selected for at least a time greater than a predetermined threshold (Column 10, lines 35-40, Figure 1, 32, 34); and a fourth unit, responsive to determining the that the first broadcasted program is selected for at least a time greater than the predetermined threshold, displaying the selected content in the electronic program guide (Column 10,

lines 18-40, Figure 1, 38, 34) as taught by Rowe in order to prevent rapid and unnecessary updates of the program display if the user is simply scrolling through the program guide (Column 10, lines 38-40) as disclosed by Rowe.

Furthermore, in *KSR International Co. Teleflex Inc.*, 127 S.Ct 1727, No. 04-1350, slip. op. at 12 (2007), the Court found that if all the claimed elements are known in the prior art then one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yield predictable results to one of ordinary skill in the art at the time of the invention.

Regarding Claim 23, Reynolds discloses a method, comprising:

receiving input identifying a first broadcasted program (Figure 4, 22, 28, Figures 2a-d, 22, Figure 3a, Figure 3b, Page 8, paragraph 0090);

determining whether a background content selection feature for a hybrid guide to supplement interactive features of the passive guide is enabled by user indication (Page 8, paragraph 0089),

in response to determining the background selection feature is enabled (Page 8, paragraph 0089), selecting content (Page 7, paragraph 0076, Figure 4, 40), based on the identified first program, to be displayed in a background area of an interactive programming guide (Figures 3a, 3b, Figures 6, 7, 8a, 8b, Pages 8-9, paragraphs 0087, 0089-0092); and

displaying the selected content in the background area of the interactive programming guide, wherein the selected content is overlapped by information to the first broadcasted program (Pages 8-9, paragraphs 0087, 0089-0091, Figure 5, 42). Reynolds is silent on determining that the first broadcasted program is selected for at least a time greater than a predetermined threshold; and responsive to determining that the first broadcasted program is selected for at least a time greater than the predetermined threshold, displaying the selected content in the electronic program guide. In analogous art, Rowe discloses a method, that perform operations, comprising: a first unit to receive input identifying a first broadcasted program (Figure 1, 32); and a second unit to select content (Figure 1, 40), based on the input, to be displayed in a background area of an interactive programming guide (Figures 2-4, 6, 92). Rowe discloses determining that the first broadcasted program is selected for at least a time greater than a predetermined threshold (Column 10, lines 35-40, Figure 1, 32, 34); and responsive to determining the that the first broadcasted program is selected for at least a time greater than the predetermined threshold, displaying the selected content in the electronic program guide (Column 10, lines 18-40, Figure 1, 38, 34). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Reynolds to include determining that the first broadcasted program is selected for at least a time greater than a predetermined threshold (Column 10, lines 35-40, Figure 1, 32, 34); and responsive to determining the that the first broadcasted program is selected for at least a time greater than the predetermined threshold, displaying the selected content in the electronic program guide (Column 10, lines 18-40,

Figure 1, 38, 34) as taught by Rowe in order to prevent rapid and unnecessary updates of the program display if the user is simply scrolling through the program guide (Column 10, lines 38-40) as disclosed by Rowe.

Furthermore, in *KSR International Co. Teleflex Inc.*, 127 S.Ct 1727, No. 04-1350, slip. op. at 12 (2007), the Court found that if all the claimed elements are known in the prior art then one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yield predictable results to one of ordinary skill in the art at the time of the invention.

Regarding Claims 2, 9 and 16, Reynolds and Rowe disclose all the limitations of Claims 1, 8 and 15 respectively. Reynolds discloses that the first broadcasted program is selected from a set of broadcasted programs displayed in the interactive programming guide (Page 9, paragraph 0098).

Regarding Claims 3, 10 and 17, Reynolds and Rowe disclose all the limitations of Claims 1, 8 and 15 respectively. Reynolds discloses that the first broadcasted program is selected by a user of the interactive programming guide (Pages 8-9, paragraphs 0088-0090, 0091 0098, Figures 3a, 3b).

Regarding Claims 4, 11 and 18, Reynolds and Rowe disclose all the limitations of Claims 1, 8 and 15 respectively. Reynolds discloses that the content includes an image from the first broadcasted program (Page 9, paragraph 0092).

Regarding Claims 5, 12 and 19, Reynolds and Rowe disclose all the limitations of Claims 1, 8 and 15 respectively. Reynolds discloses the content includes information about a subject associated with the first broadcasted program (Pages 8-9, paragraphs 0088-0090, 0091 0098, Figures 3a, 3b).

Regarding Claims 6, 13 and 20, Reynolds and Rowe disclose all the limitations of Claims 1, 8 and 15 respectively. Reynolds discloses that the content is selected based on a category of the first broadcasted program (Page 2, paragraph 0014, Figure 8b, Figure 12).

Regarding Claims 7 and 14, Reynolds and Rowe disclose all the limitations of Claims 6 and 13 respectively. Reynolds discloses the content includes information about a subject associated with the category (Figure 8b, Figure 12, Figure 13).

Regarding Claim 21, Reynolds and Rowe disclose all the limitations of Claim 15. Reynolds discloses the selected content is user generated or as the user selects or highlights a program the selected content is displayed based on the highlighting of the program (Pages 8-9, paragraphs 0089-0092, 0098).

Regarding Claim 22, Reynolds and Rowe disclose all the limitations of Claim 1. Reynolds discloses the first broadcasted program corresponds to a sporting event and the selected content including on ore more sporting event scores for the same sport as the sporting event or selecting a football talk show which provides more information including sports scores (Page 9, paragraph 0094-0096).

Regarding Claim 24, Reynolds and Rowe disclose all the limitations of Claim 23. Reynolds disclose determining whether a background selection feature is enabled

further comprises determine whether content is available for selection or based on if the user selects hybrid guide for selection of the content of the overlay (Pages 8-9, paragraphs 0087, 0089-0091).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **FARZANA E. HOSSAIN** whose telephone number is (571)272-5943. The examiner can normally be reached on Monday to Friday 7:30 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chris Kelley/
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FEH
January 5, 2009